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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,842	02/12/2001	Thomas J. Blakemore	D-2958	7727

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/781,842

Applicant(s)

BLAKEMORE ET AL

Examiner

LOVERING

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5, 7-9 AND 11-22 is/are rejected.
- ☒ Claim(s) 6 AND 10 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7, 9, 11, 13 and 15-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitchell et al., 5,741,433. The instantly-claimed controlled release additive compositions for use in an aqueous system are anticipated by Mitchell et al. (especially Examples 1, 3 and 4; Abstract; and column 3, line 35 - column 6, line 41), or are at least clearly within the purview of Mitchell et al., and thus would have been obvious therefrom to one having ordinary skill in the art at the time applicants'

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invention was made. As to the weight of the coating material based on the total weight of the tablet, see Mitchell et al., column 6, lines 37-41. Addressing the 103 aspect of this ground of rejection: As to claims 16-18 herein, it would have been obvious to one skilled in the art at the time applicants' invention was made to choose a suitable or optimum value, or range of values, within patentees' "most preferred" range of 5 to 25% wt. of coating material based on the total weight of the tablet. In this connection, see In re Aller et al., 220 F. 2d 454; 105 USPQ 233.

4. Claims 8, ~~9~~, 12 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell et al. above in view of Morishita et al., 3,960,757. The especially pertinent portions of Mitchell et al. are pointed out in the preceding paragraph. While Mitchell et al. do not disclose the use of ethyl cellulose or ethylene-vinyl acetate copolymers as a polymeric coating material in their compositions, it would have been obvious to one skilled in the art at the time applicants' invention was made to use in lieu of the vinyl acetate-butylacrylate-vinyl versatate coating in the coated tablets of Examples 3 or 4 of Mitchell et al., the ethyl cellulose of Parde et al. ethylene-vinyl acetate copolymer of Morishita et al. (paragraph bridging columns 2 and 3, noting especially column 3, lines 10 and 17; and also Example 1), since the substitution of one old slow-

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release polymeric coating material for another is not of patentable significance.

5. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell et al. above in view of Hiestand et al., 3,242,051. The especially pertinent portions of Mitchell et al. are pointed out in paragraph 3 above. While Mitchell et al. do not disclose the use of ethyl cellulose as a polymeric coating material in their compositions, it would have been obvious to one skilled in the art at the time applicants' invention was made to use in lieu of the vinyl acetate-butylacrylate-vinyl versatate coating in the coated tablets of Examples 3 or 4 of Mitchell et al., the ethyl cellulose of Hiestand et al. (column 3, line 53; and Example 4), since the substitution of one old slow-release polymeric coating material for another is not of patentable significance.

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 2-4 are substantial duplicates of independent claim 1 (upon which they depend) because the

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language in said claims relates to the environment or system to be treated in the intended process of use and doesn't constitute limitations on the claimed composition.

8. Claims 6 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the instantly-claimed controlled release additive composition for use in an aqueous system wherein the coating is a copolymer of vinyl versatate and ethylene.

10. The remaining references listed on the attached Form PTO-892 are cumulative to the references applied herein and/or further show the state of the art.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc  
March 25, 2002

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP ~~1200~~ 1700